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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,929	02/26/2001	Rainer Daus	1998CH018	3473

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CLARIANT CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
4000 MONROE ROAD  
CHARLOTTE, NC 28205

EXAMINER

BOYER, CHARLES I

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/763,929

Applicant(s)  
Daus et al

Examiner  
Charles Boyer

Art Unit  
1751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 10-13 provide for the use of an aqueous dispersion, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10-13 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-5, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al, US 5,731,450.

Alexander et al teach oil adduct conditioners for application to the skin (see abstract). An example of such a composition is a moisturizer comprising crosslinked polyacrylic acid, benzophenone, surfactants, and 55% water (col. 7, lines 40-65). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

6. Claims 1-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Palinczar, US 4,699,779.

Palinczar teaches sunscreen compositions (see abstract). An example of such a composition comprises octyl p-dimethylaminobenzoate, crosslinked acrylic acid polymer,

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ammonium hydroxide as a dispersant, and 70% water (col. 13, example 8). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

7. Claims 1-5, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaudhuri et al, US 5,736,128

Chaudhuri et al teach cosmetic compositions for the rejuvenation of skin (see abstract). An example of such a composition comprises octyl methoxycinnamate, crosslinked acrylic acid polymer, surfactants, and 61% water (col. 10, example 8). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

8. Claims 1-6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Narayanan et al, US 5,597,574.

Narayanan et al teach sunscreen compositions (see abstract). An example of such a composition comprises octocrylene, crosslinked maleic acid/methyl vinyl ether copolymer, surfactants, and 90% water (col. 7, example 12). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

9. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Duvel, US 5,945,093.

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Duvel teaches conditioning shampoo compositions (see abstract). An example of such a composition comprises PVM/MA decadiene crosspolymer, surfactants, optional ingredients, and approximately 70% water (col. 7, table 1) where suitable optional ingredients of the invention include dyes and UV absorbers such as benzophenones (col. 7, lines 4-7). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

10. Claims 1-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Langer et al, US 5,243,021.

Langer et al teach sunscreen compositions for skin and fabrics (see abstract). An example of such a composition comprises sunscreens, crosslinked acrylic acid polymer, surfactants, and 54% water (col. 17, example II). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

11. Claims 1-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Borgerding et al, US 4,215,004.

Borgerding et al teach laundry detergent compositions (see abstract). An example of such a composition comprises optical brightener, crosslinked acrylic acid polymer, surfactants, and 61% water (col. 10, example 8). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

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12. Claims 1-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Rek, US 4,556,504.

Rek teaches laundry detergent compositions (see abstract). An example of such a composition comprises optical brightener, crosslinked acrylic acid polymer, surfactants, and the balance water (col. 3, example 4). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langer et al, US 5,243,021.

Langer et al are relied upon as set forth above. Recall that the UV absorbers of Langer et al may be used as fabric care compositions to prevent the fading of garments (col. 1, lines 33-35 and col. 3, lines 43-45). It would have been obvious to one of ordinary skill in the art to use the UV absorbers of Langer et al in textile treatments and so meet the material limitations of the claims at hand, as such compositions are clearly envisioned by Langer et al.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Boyer whose telephone number is (703) 308-2524. The examiner can normally be reached on Monday-Friday from 9:30 AM - 6:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 872-9310 for non-after-final amendments and (703) 872-9311 for after-final amendments.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Charles Boyer

A handwritten signature in cursive script that reads "Charles Boyer". The signature is written in black ink and is positioned to the right of the printed name "Charles Boyer".

August 19, 2003